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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,953	07/11/2001	Achim H. Krotz	ISIS-4797	9234

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EXAMINER

SCHULTZ, JAMES

ART UNIT PAPER NUMBER

1635

DATE MAILED: 03/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/902,953

Applicant(s)

KROTZ ET AL.

Examiner

J. Douglas Schultz

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 February 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-14 for reasons of record.

Claim(s) withdrawn from consideration: \_\_\_\_\_

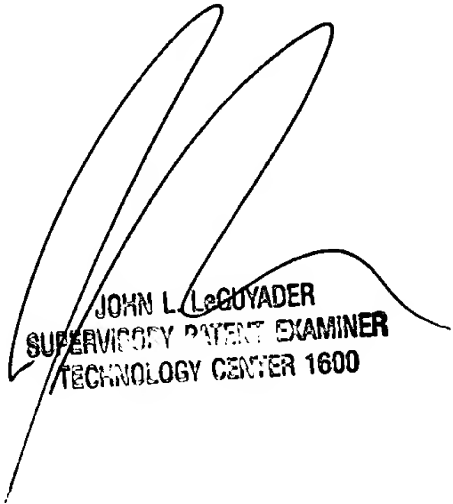
8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

Continuation of 2. NOTE: The proposed amendment to claim 1 to add the language "peptide nucleic acid" will not be entered since it raises new prior art and/or new search issues not previously considered.

Continuation of 3. Applicant's reply has overcome the following rejection(s): the rejection of claims 6 and 11 under 35 U.S.C. § 103(a). It is agreed that the compounds of Burt do not meet the structural limitations of claims 6 and 11.

Continuation of 5. does NOT place the application in condition for allowance because: applicants arguments reiterate those that are addressed in the final rejection mailed November 20, 2002. Briefly, regarding applicants' arguments that the examiner engaged in improper picking and choosing in formulating the rejection under 35 U.S.C. § 102(b) over Zhang et al., it is noted that applicants repeatedly cite the need to "at once envisage" the claimed compound. The context in which the "at once envisage" phrase is used in M.P.E.P. 2131.02 is in choosing substituents from a list of alternatives in a chemical formula, which is not analogous to the instant situation. A more pertinent discussion to applicants' situation is found in the the preceding paragraph of M.P.E.P. 2131.02, wherein it is cited that a reference specifically naming one chemical as an additive amongst a list of many suitable salts in a particular compound anticipated the claims. This citation closely mirrors the facts of applicants' case, wherein applicants traversal of said rejection is based on the assertion that one would have to improperly pick and choose one of several additives disclosed in the prior art to arrive at applicants' invention, when in fact, none is required. It is also noted that applicants argue that Zhang et al. discloses no emulsions. This is not considered relevant, because the claims do not recite such emulsions.

Regarding Applicants' traversal of 35 U.S.C. § 103(a), these arguments have also been addressed in the final rejection referenced above. Briefly, Applicants' traversal is based on the idea that although the prior art discloses both water soluble and oil soluble antioxidants, that the prior art fails to suggest the selection of water soluble antioxidants over non-water soluble antioxidants. In response, it is pointed out that there are only two types of soluble antioxidants, i.e. water soluble and non-water soluble. The prior art clearly discloses that a water soluble antioxidant is a preferred embodiment. Thus Applicant's argument that the prior art fails to suggest the selection of water soluble antioxidants is not considered convincing. Applicants' arguments regarding "picking and choosing" of phosphorothioate modifications is not considered convincing for the same reasons discussed above in the rejection of claims under 35 U.S.C. § 102(b).



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